

AMENDMENTS TO THE DRAWINGS:

The attached two (2) sheets of drawings include changes to Figs. 4, 5 and 7. These two sheets, which include Figs. 4, 5 and 7, replace the original sheets including Figs. 4, 5 and 7. In Figs. 4, 5 and 7, descriptive texts for the boxes have been provided.

Attachments: 2 replacement sheets

REMARKS

I. Introduction

Claims 37 to 72 are pending in the present application. Claims 37, 64 and 72 have been amended. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

II. Drawing Objections

In response to the Examiner's objection to the drawings, Applicant submits herewith two (2) replacement sheets containing amended Figs. 4, 5 and 7, which include the descriptive text for the various boxes. Withdrawal of the drawing objection is respectfully requested.

III. Rejection of Claims 37-48, 64-66 and 68-72 under 35 U.S.C. § 102(e)

Claims 37-48, 64-66 and 68-72 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,386,872 ("Shimizu"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(e), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or

technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

Amended claim 37 recites, in relevant parts, “exchanging data between the data memory of the capturing device and the at least one recording device, whereby **a virtual data memory is formed for the capturing device** by operational association between the data memory of the capturing device and the at least one recording device; **at the capturing device, receiving a request from a user to access the exchanged data, wherein the request does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory**; and responsive to the request, **retrieving the exchanged data stored on the virtual data memory**, the retrieving occurring at the capturing device.” Amended claims 64 and 72 recite features analogous to the above-recited features of claim 37. Support for the claim amendments can be found, e.g., on page 2, lines 18 to 28 of the Substitute Specification filed on July 1, 2005.

In support of the rejection, the Examiner contends that the moving image storage server of Shimizu provides a virtual memory for a digital video camera. However, it is readily apparent that Shimizu does not describe or even suggest **a virtual data memory for the capturing device**, as any review of Shimizu would show. According to Shimizu, images captured by the digital video camera are transmitted in real time for storage at the storage server. Shimizu does not contemplate later accessing of the storage server images by the digital video camera. Instead, Shimizu describes a live distribution system in which other devices access the images stored on the storage server. As seen in Fig. 4, Shimizu’s system shows a plurality of client terminals that are networked to the storage server in order to access the stored images. Because the storage server only provides for **retrieval of the stored images by other devices and not the digital video camera**, the storage server cannot possibly provide a virtual data memory for the capturing device.

In addition, there is no suggestion in Shimizu regarding the amended features of “**at the capturing device, receiving a request from a user to access the exchanged data,**

wherein the request does not differentiate between data stored on the data memory of the capturing device and data stored on the virtual data memory; and responsive to the request, retrieving the exchanged data stored on the virtual data memory.”

For at least the foregoing reasons, there is absolutely no basis to support the anticipation rejection of claims 37, 64 and 72, and their dependent claims 38-48, 65, 66 and 68-71. Withdrawal of the anticipation rejection is respectfully requested.

IV. Rejection of Claims 49, 51-63 and 67 under 35 U.S.C. § 103(a)

Claims 49, 51-63 and 67 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of U.S. Patent No. 5,724,475 (“Kirsten”). Applicant respectfully submits that the pending claims are patentable over the applied references for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

Claims 49, 51-63 and 67 are ultimately dependent on claim 37 or 64. As noted above, Shimizu fails to anticipate parent claims 37 and 64. In addition, the teachings of Kirsten do not remedy the deficiencies of Shimizu as applied against claims 37 and 64, let alone suggest the limitations of dependent claims 49, 51-63 and 67. Accordingly, claims 49, 51-63 and 67 are allowable over the applied combination of references.

In view of all of the foregoing, withdrawal of the obviousness rejection of claims 49, 51-63 and 67 is respectfully requested.

V. Rejection of Claim 50 under 35 U.S.C. § 103(a)

Claim 50 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu in view of Kirsten and U.S. Patent No. 6,954,859 (“Simerly”). Applicant respectfully submits that the pending claims are patentable over the applied references for at least the following reasons.

Claim 50 is ultimately dependent on claim 37. As noted above, the combination of Shimizu and Kirsten fails to render parent claim 37 obvious. In addition, the teachings of Simerly do not remedy the deficiencies of Shimizu and Kirsten as applied against claim 37, let alone suggest the limitations of dependent claim 50. Accordingly, claim 50 is allowable over the applied combination of references.

In view of all of the foregoing, withdrawal of the obviousness rejection of claim 50 is respectfully requested.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

 (R. NO. 36,197)

Dated: June 15, 2009

By: JONG LEE for Gerard Messina
Gerard A. Messina
(Reg. No. 35,952)
KENYON & KENYON LLP
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646